

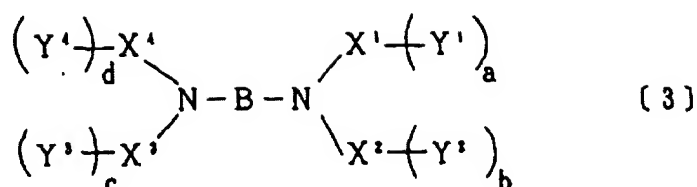
REMARKS

Claims 1-8, as amended, remain herein. Claim 1 has been amended. New claim 8 has been added. Support for the amendment and the new claim can be found throughout the specification (see, e.g., compounds 1-3, 5-12, and 14-19 at pages 11-12 of the specification).

1. Claims 1-7 were rejected under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) over either of Hosokawa EP 1061112 and JP 2001-131541, and under 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) over either of Hosokawa U.S. Patents 6,951,693 and 6,743,948. The Office Action states that JP 2001-131541 and U.S. Patents 6,951,693 and 6,743,948 are patent family equivalents of EP 1061112.

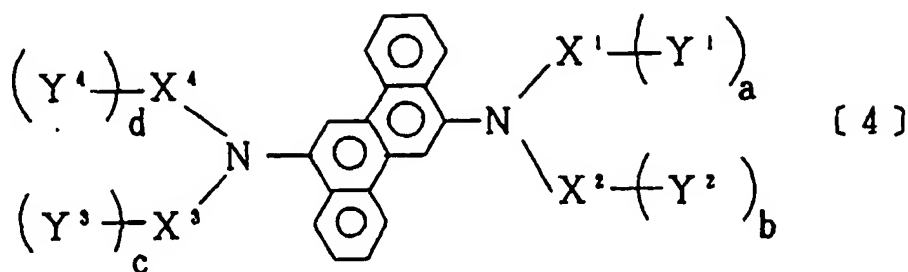
Claims 1-7 were previously rejected in the Office Action dated March 22, 2006 over these references as applied above. However, in view of applicant's amendment and remarks filed September 22, 2006, the rejection was withdrawn "due to the amendment requiring at least one specific 'A' substituent group on the phenyl rings of formulas I and II" (Office Action, December 5, 2006). The Office Action dated May 10, 2007 has reinstituted this rejection apparently because "X groups may include substituted arylenes, which would include at least one 'A' group as required by claim 1 (see EP claim 2)." The Office Action also points to Hosokawa's formula [4] in support of the rejection under 35 U.S.C. § 102(b) or § 103(a).

Hosokawa EP '112 claim 2 recites the following formula (3) wherein X¹ to X⁴ each independently represents a substituted or unsubstituted arylene group having 6 to 30 carbon atoms:



Hosokawa formula [4] is similar to formula [3] but further discloses a chrysene group between the two N atoms.

General formula [4]



wherein X^1 to X^4 , Y^1 to Y^4 and a to d are the same as those in formula [3].

Applicant's claim 1 recites formulas (I) and (II) wherein each N atom is substituted by two phenylene groups, which in turn are themselves substituted by the specific substituents disclosed in claim 1. Hosokawa does not disclose or teach that one of the X^1 to X^4 arylene groups must be substituted (i.e., a to d can be zero), unlike applicant's claim 1. Hosokawa discloses a broad genus and applicant's claimed compounds are species within that genus. When a compound is not specifically named, but instead it is necessary to select portions of teachings

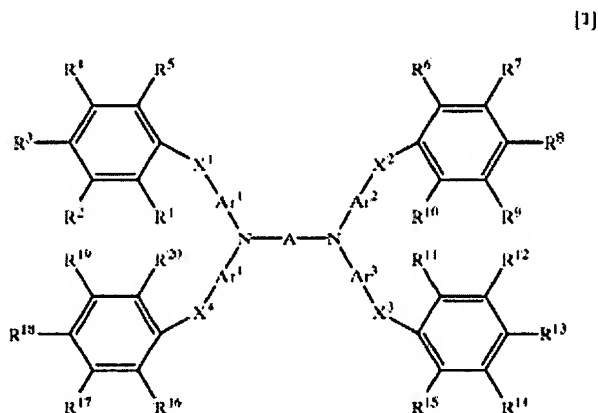
within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. Ex parte A, 17 USPQ2d 1716 (BPAI 1990); MPEP 2131.02. The species is anticipated only if one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. See In re Petering, 301 F.2d 676 (CCPA 1962); MPEP 2131.02. Furthermore, one may look to the preferred embodiments to determine which compounds can be anticipated. Id. One may not envisage at once the compound of the present application from Hosokawa's generic chemical formula. To get to the claimed species of the present application, each of a, b, c, and d in Hosokawa's formula [4] must be zero; X^1 to X^4 which are arylene (which encompasses a very broad range of chemical groups) must be phenylene; one of X^1 to X^4 must be substituted; and the substituent to one of X^1 to X^4 must be either an alkyl, aryl, or alkoxy group (given). In addition, the claimed species does not read on the exemplified compounds. Thus, Hosokawa does not anticipate applicant's claims.

Furthermore, applicant's claim 1 is not obvious in view of Hosokawa. The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. See In re Baird, 16 F.3d 380, 382 (Fed. Cir. 1994); MPEP 2144.08. Applicant's claim 1 recites "an organic electroluminescent device material, capable of emitting blue light." There is no indication in Hosokawa that the disclosed compounds emit blue light. Instead, Hosokawa states that "[b]y using a doping material, luminance and the efficiency of light emission can be improved and blue light and red light can be emitted" (see Hosokawa '948 at column 90, lines 62-64). Thus, Hosokawa suggests that the

disclosed compounds do not emit blue light and that the use of doping material is required to achieve this capability.

For the foregoing reasons, Hosokawa does not disclose all elements of applicant's claimed invention, and further discloses nothing that would have suggested applicant's claimed invention to one of ordinary skill in the art. Furthermore, there is no disclosure or teaching in Hosokawa, or otherwise in this record that would have suggested the desirability of modifying any portions thereof effectively to anticipate or suggest applicant's presently claimed invention. For all the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of this rejection and allowance of all claims 1-7.

2. Claims 1-7 were also rejected under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) over Onikubo U.S. Patent 6,280,859. The Office Action states that Onikubo's formula [1] discloses an A group which may be a fused aromatic group, an Ar group which may be a substituted aromatic group, and an X group which may be an alicyclic residue. Onikubo's formula [1] is as follows:



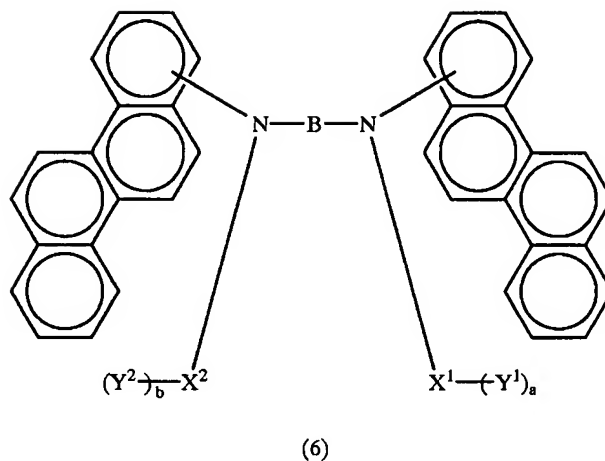
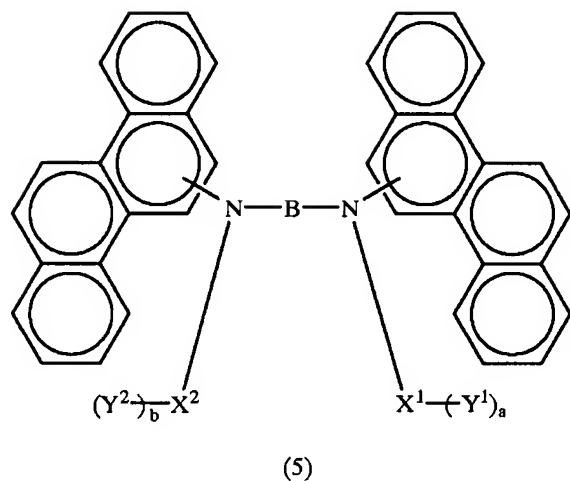
Onikubo does not anticipate applicant's claim 1. As discussed above, when a compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. Ex parte A, 17 USPQ2d 1716 (BPAI 1990); MPEP 2131.02. The species is anticipated only if one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. See In re Petering, 301 F.2d 676 (CCPA 1962); MPEP 2131.02. Furthermore, one may look to the preferred embodiments to determine which compounds can be anticipated. Id. One may not envisage at once the compounds of the present application from Onikubo's chemical formula. To get to applicant's claimed compounds, Onikubo's A group which may be a fused aromatic group (which encompasses a very broad range of chemical groups) must be chrysene, each Onikubo's Ar¹ to Ar⁴ must be a phenyl ring; and each of applicant's A₁ to A₈ groups must be either aryloxy (in which case Onikubo's groups X¹ to X⁴ must be -O-), or a cycloalkyl group substituted with an aryl group. In addition, applicant's claimed compounds do not read on any of Onikubo's exemplified compounds. Thus, Onikubo does not anticipate applicant's claims.

Furthermore, Applicant's claim 1 is not obvious in view of Onikubo. Applicant's claim 1 recites "an organic electroluminescent device material, capable of emitting blue light." There is no indication in Onikubo that the disclosed compounds emit blue light. Instead, Onikubo states that "a dopant can improve the light emission brightness and the light emission efficiency, and can attain the red or blue light emission." (see Onikubo at column 179, lines 48-51). Thus,

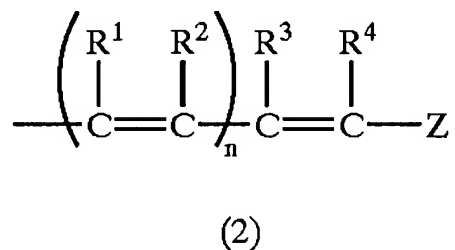
Onikubo suggests that the disclosed compounds do not emit blue light and that the use of doping material is required to achieve this capability.

Therefore, Onikubo does not anticipate applicant's claimed invention, and further discloses nothing that would have suggested applicant's claimed invention to one of ordinary skill in the art. Furthermore, there is no disclosure or teaching in Onikubo, or otherwise in this record that would have suggested the desirability of modifying any portions thereof effectively to anticipate or suggest applicant's presently claimed invention. For all the foregoing reasons, applicant respectfully requests reconsideration and withdrawal of this rejection and allowance of all claims 1-7.

3. Claims 1 and 2 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-2 of Hosokawa et al. U.S Patent No. 6,743,948. Hosokawa '948 claims 1 and 2 recite compounds of formula (5) and (6) respectively:



wherein B represents a substituted or unsubstituted arylene group having 6 to 60 carbon atoms, with the proviso that the relationship of $a+b>0$ is given when the number of carbon atoms of B is 26 or less, X^1 and X^2 each independently represent a substituted or unsubstituted arylene group having 6 to 30 carbon atoms, X^1 and X^2 may be bonded to each other, Y^1 and Y^2 each independently represent an organic group represented by general formula (2), a and b each represent an integer of 0 to 2; general formula (2) being:



Each of claims 1 and 2 includes the proviso that when the number of carbon atoms of B is 26 or less, $a+b>0$. Thus, Hosokawa '948 claimed compounds include at least one Y^1 or Y^2 group. Applicant's claimed compounds, however, do not include such substituents. Thus,

claims 1 and 2 of Hosokawa '948 do not disclose all elements of applicant's claims 1 and 2. In addition, as discussed above, Applicant's claim 1 is not obvious over Hosokawa '948 because it recites "an organic electroluminescent device material, capable of emitting blue light" and there is no indication in Hosokawa '948 that the disclosed compounds emit blue light. Thus, claims 1 and 2 of Hosokawa '948 are not a proper basis for a rejection under nonstatutory obviousness-type double patenting.

4. Claims 3-7 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-2 of Hosokawa et al. U.S Patent No. 6,743,948 in view of Hosokawa et al. U.S. Patent No. 6,951,693. The Office Action states that claims 1-2 of Hosokawa '948 disclose Applicant's claimed compounds. As discussed above, claims 1 and 2 of Hosokawa '948 do not disclose all elements of applicant's claims and are not a proper basis for a rejection under nonstatutory obviousness-type double patenting. Because Hosokawa '693 does not teach what is missing from claims 1 and 2 of Hosokawa '948, claims 1-2 of Hosokawa '948 in view of Hosokawa '693 are also not a proper basis for a rejection under nonstatutory obviousness-type double patenting.

5. Claims 1-7 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-11 of Funahashi U.S. Patent Application No. 11/282,697. Applicant may be willing to submit a terminal disclaimer to address this rejection if the current claims of the present application are deemed otherwise allowable.

For all the foregoing reasons, all claims 1-8 are now proper in form and patentably distinguished over all grounds of rejection cited in the Office Action. The PTO is hereby authorized to charge or credit any necessary fees to Deposit Account No. 19-4293. Should the Examiner deem that any further amendments would be desirable in placing this application in even better condition for issue, he is invited to telephone applicant's undersigned representative.

Respectfully submitted,

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